

REMARKS**I. Status of the Claims**

In the Office Action of March 17, 2005,¹ claims 3-6, 9-14, 16-21, 24, 28-31, 34-39, 41-46, and 49 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,061,713 to *Bharadhwaj* (“*Bharadhwaj*”) in view of U.S. Patent No. 6,003,065 to *Yan et al.* (“*Yan*”); claims 7-8, 22-23, 25, 26, 32, 33, 47, 48, and 50 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Bharadhwaj* in view of *Yan* further in view of U.S. Patent No. 6,282,581 to *Moore et al.* (“*Moore*”); and claims 15, 27, 40, and 52 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Bharadhwaj* in view of *Yan* further in view of U.S. Patent No. 6,219,675 to *Pal et al.* (“*Pal*”). Applicants address the rejections below.

II. Rejection of claims 3-6, 9-14, 16-21, 24, 28-31, 34-39, 41-46, and 49 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 3-6, 9-14, 16-21, 24, 28-31, 34-39, 41-46, and 49 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established. As M.P.E.P. § 2142 states, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

With regard to independent claim 3, the Examiner failed to establish that the applied references teach or suggest each and every feature of the claim. In rejecting claim 3, the Examiner alleged that *Bharadhwaj* discloses "forming a task request from parameters and data" (Office Action "OA" at 3). This allegation by the Examiner is not supported by *Bharadhwaj*. *Bharadhwaj* describes a system for simplifying the communications between clients and servers via a global naming system. See col. 3, lines 34 et seq. As the Examiner noted, *Bharadhwaj* discloses that a request from a client to a "global namer module," which supplies identifiers for port service modules and domain ports, "includes a name of service [and] . . . the port service handle, provided by the server program" (col. 3, lines 63-65; OA at 3). *Bharadhwaj*'s disclosure that global namer module requests include service names and port service handles provided by server programs does not support the Examiner's allegation that *Bharadhwaj* discloses "forming a task request from parameters and data." To begin with, the Examiner provides no evidence, beyond conjecture, showing that *Bharadhwaj*'s request to the global namer module is consistent with a "task request." In fact, according to *Bharadhwaj*, the global namer module merely provides identifiers for the port service module and domain port "to which a request for the service should be directed" (col. 3, lines 35-39). Further, the mere fact that *Bharadhwaj*'s global namer module request includes service names and port service handles does not show that the reference discloses or suggests "forming a task request from parameters and data," as alleged by the Examiner. For at least these reasons, the Examiner's allegation that *Bharadhwaj* discloses "forming a task request from parameters and data" is not supported.

Additionally, in an attempt to establish *prima facie* obviousness with respect to claim 3, the Examiner alleged that *Yan* teaches “the server downloading any needed executable byte code . . . and invoking a generic compute technique capable of executing the task request on the selected server,” which is not disclosed by *Bharadhwaj* (OA at 3). The Examiner noted *Yan*’s disclosure that, when an a user of an application selects a peripheral device, “the portion of the application concerned with using the functions associated with the peripheral device is downloaded into the peripheral device” and that “the peripheral device application executes on the peripheral device” (col. 19, lines 23-53, 54-64; OA at 3). In addition, the Examiner noted that each peripheral device in *Yan*’s system includes a processing unit, which implements a “virtual machine instruction processor” and that virtual machine instructions associated with the application are typically executed on the peripheral device. (col. 7, lines 9-22; OA at 3).

The Examiner’s allegation that *Yan* discloses “the server downloading any needed executable byte code . . . and invoking a generic compute technique capable of executing the task request on the selected server” is not supported by the reference. For example, downloading into a peripheral device a portion of an application concerned with using that peripheral device, as disclosed by *Yan*, does not constitute “the server downloading any needed executable byte code,” as alleged by the Examiner. Furthermore, executing virtual machine instructions associated with the application on a peripheral device, as disclosed by *Yan*, does not constitute “the server . . . invoking a generic compute technique capable of executing the task request on the selected server,” as alleged. For at least these reasons, the Examiner failed to support a *prima facie* conclusion of obviousness with respect to claim 3.

Further, with respect to claim 3, the requisite motivation for combining *Bharadhwaj* and *Yan* is lacking. Determinations of obviousness must be supported by evidence on the record.

See In re Zurko, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Moreover, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Examiner has not shown by “clear and particular” evidence that a skilled artisan considering *Bharadhwaj* and *Yan*, and not having the benefit of Applicants’ disclosure, would have modified or combined the references in a manner alleged. The Examiner alleged that a skilled artisan would have combined the references “since the method of *Bharadhwaj* . . . would benefit greatly from the distributed processing of applications that is set forth by *Yan*” (OA at 3). The Examiner avers (OA at 3):

Bharadhwaj presents a means of allowing a client to locate an optimal server to perform a request, which is substantially similar to the distributed processing method presented by *Yan* . . . The combination [of the systems] . . . allows the interoperability of a client-server architecture across varying communication protocols [and] . . . across varying operating environments.”

These allegations by the Examiner are not supported and do not show that a skilled artisan would have combined the references as alleged. To begin with, the Examiner’s conjectural allegation that *Bharadhwaj*’s communication system and *Yan*’s peripheral device architecture are “substantially similar” is not properly supported by evidence. Further, the Examiner failed to provide “clear and particular” evidence showing that the alleged combination would allow “interoperability of a client-server architecture across varying communication protocols [and] . . .

across varying operating environments.” The Examiner merely alleged that *Bharadhwaj* and *Yan* teach certain features, without providing a proper motivation for combining the systems.

As M.P.E.P. § 2143.01 makes clear, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). In this case, the Examiner has not shown that *Bharadhwaj* and *Yan* “suggests the desirability” of the alleged modification.

Furthermore, as M.P.E.P. § 2141.02 articulates, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (internal citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.* In this case, the Examiner merely alleged that *Bharadhwaj* and *Yan* disclose certain subject matter and has not established that the claimed invention as a whole would have been obvious. Instead, the Examiner appears to be improperly using Applicants’ claims in hindsight to reconstruct the prior art.

For at least the reasons advanced above, *prima facie* obviousness has not been established with respect to independent claim 3 and the rejection of claim 3 under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claims 4-6, 9-14, 16, and 17 should be withdrawn as well, at least because these claims depend from base claim 3. Applicants therefore request withdrawal of

the § 103(a) rejection of claims 3-6, 9-14, 16, and 17 and the timely allowance of these pending claims.

With regard to independent claim 18, the Examiner failed to establish that the applied references teach or suggest each and every feature of the claim. In rejecting independent claim 18, the Examiner alleged that *Bharadhwaj* discloses “assembling parameters and data from a task request into a task.” To support this allegation, the Examiner noted *Bharadhwaj*’s disclosure that a request from a client to a global namer module “includes a name of service [and] . . . the port service handle, provided by the server program” (col. 3, lines 63-65; OA at 6). Applicants disagree with the Examiner’s characterization of *Bharadhwaj*. Sending a request from a client to a global namer module, which supplies identifiers for the port service module and domain port “to which a request for the service should be directed” (col. 3, lines 35-39), does not constitute “assembling parameters and data from a task request into a task,” even if the request includes service names and port service handles. Indeed, contrary to the Examiner’s assertions, *Bharadhwaj* fails to teach or suggest “assembling parameters and data from a task request into a task.”

Additionally, in an attempt to establish *prima facie* obviousness with respect to claim 18, the Examiner alleged that *Yan* teaches “downloading any needed executable byte code . . . and invoking a generic compute method on the server, which is capable of processing a plurality of types of tasks,” which is not disclosed by *Bharadhwaj* (OA at 6). These allegations by the Examiner are not supported by *Yan*. For example, contrary to the Examiner’s position (OA at 6), downloading portions of an application into a peripheral device and executing virtual machine instructions associated with the application on the peripheral device, as disclosed by *Yan*, does not constitute “downloading any needed executable byte code . . . and invoking a generic

compute method on the server, which is capable of processing a plurality of types of tasks,” as alleged. For at least these additional reasons, the Examiner failed to support a *prima facie* conclusion of obviousness with respect to claim 18.

Moreover, the requisite motivation for combining *Bharadhwaj* and *Yan* is lacking with regard to claim 18. To the extent the Examiner contends that a skilled artisan would have been motivated to combine *Bharadhwaj* and *Yan* for the reasons set forth in the rejection of claim 3, Applicants traverse that contention for at least reasons similar to those presented above in connection with claim 3.

For at least the reasons advanced above, the § 103(a) rejection of claim 18 should be withdrawn. The rejection of claims 19-21 and 24 should be withdrawn as well, at least because these claims depend from base claim 18. Applicants therefore request withdrawal of the § 103(a) rejection of claims 18-21 and 24 the timely allowance of these pending claims.

With regard to independent claim 28, the Examiner alleged that *Bharadhwaj* “teaches the invention as claimed, including . . . the method of claims 3-17” (OA at 7). Similarly, with regard to independent claim 43, the Examiner alleged that *Bharadhwaj* “teaches the invention as claimed, including . . . the method of claims 18-21 and 24” (OA at 10). For at least reasons similar to those presented above in connection with claims 3 and 18, the § 103(a) rejection of claims 28 and 43 should be withdrawn. The § 103(a) rejection of claims 29-31, 34-39, 41, 42, 44-46, and 49 should also be withdrawn, at least because of the respective dependence of those claims upon base claims 28 and 43. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 28-31, 34-39, 41-46, and 49.

III. Rejection of claims 7, 8, 22, 23, 25, 26, 32, 33, 47, 48 and 50 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 7, 8, 22, 23, 25, 26, 32, 33, 47, 48 and 50 under 35 U.S.C. § 103(a) for the following reasons.

Claims 7 and 8 depend from claim 3. For at least the reasons presented above in connection with claim 3, the rejection of claims 7 and 8 is not supported by *Bharadhwaj* and *Yan*. Further, the Examiner has not established that *Moore* provides support for the rejection. *Moore* is directed to a communications framework “operable to support remote method invocation in a distributed object environment” (Abstract). The Examiner has not established that *Moore* teaches or suggests at least the following alleged features not disclosed by *Bharadhwaj* and *Yan*: “the server downloading any needed executable byte code . . . and invoking a generic compute technique capable of executing the task request on the selected server” For at least this reason, the rejection of claims 7 and 8 should be withdrawn.

Furthermore, the requisite motivation to combine *Bharadhwaj*, *Yan*, and *Moore* is lacking. As explained above in connection with claim 3, the Examiner has not shown by “clear and particular” evidence that a skilled artisan considering *Bharadhwaj* and *Yan* would have been motivated to combine the references in the manner alleged. In addition, the Examiner has not shown by “clear and particular” evidence that a skilled artisan would have combined *Moore* with *Bharadhwaj* and *Yan*. According to the Examiner (OA at 8), a skilled artisan would have combined the references “since in a distributed computing environment, different computers may be running different platforms or have incompatible communication protocols.” These statements by the Examiner do not establish the required motivation to combine the references. That *Moore* might mention a “platform independent” protocol and remote method invocation that could allegedly “allow distributed computing” does not evidence that a skilled artisan would

have combined the references as alleged. Although the Examiner alleges that *Moore*'s teachings would "allow distributed computing for a number of types of systems to interact," the Examiner provides no evidence or reasoning to show how combining *Moore* with *Bharadhwaj* and *Yan* would achieve those results or even how a skilled artisan would combine the references.

Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. For at least these additional reasons, the rejection of claims 7 and 8 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 22, 23, 25, and 26 depend from base claim 18. For at least reasons similar to those presented above in connection with claim 18, the rejection of claims 22, 23, 25, and 26 is not supported by *Bharadhwaj* and *Yan*. Further, the Examiner has not established that *Moore* provides support for the rejection. The Examiner has not established that *Moore* teaches or suggests at least the following alleged features missing from *Bharadhwaj* and *Yan*:

"downloading any needed executable byte code . . . and invoking a generic compute method on the server, which is capable of processing a plurality of types of tasks." Furthermore, with respect to claims 22, 23, 25, and 26, the Examiner failed to show the requisite motivation to combine the references. For at least these reasons, the rejection of claims 22, 23, 25, and 26 under 35 U.S.C. § 103(a) should be withdrawn.

With regard to claims 32 and 33, the Examiner alleged that *Bharadhwaj* "teaches the invention as claimed, including . . . the method of claims 7-8" (OA at 9). With regard to claims 46-48 and 50, the Examiner alleged that *Bharadhwaj* "teaches the invention as claimed, including . . . the method of claims 22-23 and 25" (OA at 10).

Claims 32 and 33 depend from claim 28, and claims 46-48 and 50 depend from claim 43. Applicants submit that the rejection of claims 32 and 33 is not supported by the cited art at least because *Bharadhwaj* and *Yan* fail to teach or suggest at least “the server downloading any needed executable byte code . . . and invoking a generic compute technique capable of executing the task request on the selected server,” as alleged, and because the Examiner failed to establish that *Moore* cures these deficiencies. Also, with respect to claims 32 and 33, the Examiner failed to show the requisite motivation to combine the applied references.

The rejection of claims 46-48 and 50 is equally unsupported, at least because *Bharadhwaj* and *Yan* fail to teach or suggest “downloading any needed executable byte code . . . and invoking a generic compute method on the server, which is capable of processing a plurality of types of tasks,” as alleged, and because the Examiner failed to establish that *Moore* cures these deficiencies. Also, with respect to claims 46-48 and 50, the Examiner failed to show the requisite motivation to combine the applied references. For at least the reasons advanced above, the rejection of claims 32, 33, 46-48 and 50 under 35 U.S.C. § 103(a) should be withdrawn.

For the foregoing reasons, Applicants request withdrawal of the rejection of claims 7, 8, 21-23, 25, 26, 32, 33, 46-48 and 50 under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

IV. Rejection of claims 15, 27, 40 and 52 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 15, 27, 40, and 52 under 35 U.S.C. § 103(a) for the following reasons.

Claim 15 depends from claim 3. For at least the reasons presented above in connection with claim 3, the rejection of claim 15 is not supported by *Bharadhwaj* and *Yan*. Further, the Examiner has not established that *Pal* supports the rejection. The Examiner has not established

that *Pal* teaches or suggests at least the following alleged features not disclosed by *Bharadhwaj* and *Yan*: “the server downloading any needed executable byte code . . . and invoking a generic compute technique capable of executing the task request on the selected server,” as alleged.

Additionally, contrary to the Examiner’s allegations, *Pal* does not teach or suggest “indicating to the server that results from a computed task should be stored in a result cache on the selected server for subsequent tasks to use.” The relied-upon portion of *Pal* mentions that a “secondary storage device 412 contains an object cache 426 that contains . . . results of previous queries performed on the DBMS 206” (col. 7, line 47 – col. 8, line 11; OA 10). Although *Pal* mentions caching database objects for subsequent use, the reference does not teach or suggest “indicating to the server that results from a computed task should be stored in a result cache on the selected server for subsequent tasks to use,” as asserted by the Examiner. Caching by a server is not the same as indicating to a server that results should be stored in a cache for subsequent tasks. That a server places results in a cache does not signify that the server receives an indication to cache results from a task. For at least these reasons, the rejection of claim 15 is not supported by the cited references and should thus be withdrawn.

Moreover, the Examiner failed to show the requisite motivation to combine *Pal* with *Bharadhwaj* and *Yan*. The Examiner does not show that a skilled artisan having the cited art before him would have been motivated to combine the references in the manner alleged. According to the Examiner (OA page 10), a skilled artisan would have combined the references “since in the case that subsequent tasks perform similar operations, or may perform additional work on an object, storing the result cache on the server would reduce the required execution time . . . [and] reduces the communication time associated with a network.” This position is not properly supported by clear and particular evidence. For example, the Examiner fails to show

that combining the references would indeed reduce the “required execution time” or the “communication time associated with a network” in the systems disclosed by the references. For at least these additional reasons, the rejection of claim 15 under 35 U.S.C. § 103(a) should be withdrawn.

Claim 27 depends from claim 18. For at least the reasons presented above in connection with claim 18, the rejection of claim 27 is not supported by *Bharadhwaj* and *Yan*. Further, *Pal* does not provide support for the rejection. The Examiner has not established that *Pal* teaches or suggests at least the alleged features of “downloading any needed executable byte code . . . and invoking a generic compute method on the server, which is capable of processing a plurality of types of tasks,” which are not disclosed by *Bharadhwaj* and *Yan*.

In addition, contrary to the Examiner’s allegations, *Pal* does not teach or suggest “storing the results from the task in a cache if a subsequent task will use the results” as asserted by the Examiner (OA at 11). The Examiner notes *Pal*’s disclosure of an “object cache 426 [containing] . . . results of previous queries performed on the DBMS 206” (col. 7, line 47 – col. 8, line 11). Although *Pal* mentions caching database objects for subsequent use, the reference does not teach or suggest “storing the results from the task in a cache if a subsequent task will use the results,” as alleged by the Examiner. Indiscriminately caching results of queries does not constitute “storing the results from the task in a cache if a subsequent task will use the results.” For at least these reasons, the rejection of claim 27 is not supported by the cited art and should be withdrawn. Further, *prima facie* obviousness has not been established with respect to claim 27 at least because the requisite motivation to combine the references is lacking.

With regard to claim 40, the Examiner alleged that *Bharadhwaj* “teaches the invention as claimed, including . . . the method of claims 15” (OA at 11). In rejecting claim 52, the Examiner

alleges that *Bharadhwaj* “teaches the invention as claimed, including . . . the method of claims 27” (OA at 11). Applicants submit that the rejection of claims 40 and 52 is unsupported by the cited art for at least reasons similar to those presented above in connection with claims 15 and 27. Further, *prima facie* obviousness has not been established with respect to these claims at least because the requisite motivation to combine the references is lacking.

Because the applied art fails to support a *prima facie* conclusion of obviousness with respect to claims 15, 27, 40, and 52 under 35 U.S.C. § 103(a), Applicants request withdrawal of the rejection and the timely allowance of these pending claims.

V. Conclusion


Applicants request the reconsideration and reexamination of this application in view of the foregoing and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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